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OFFICE OF PETITIONS

In re Application of	:	
Johnson	:	DECISION
Application No.: 09/204,866	:	
Filing Date: 3 December, 1998	:	
Attorney Docket No. PA1.615	:	

This is a decision on the petition filed on 13 March, 2006, to withdraw the holding of abandonment and considered under 37 C.F.R. §1.181, alternatively, to revive the application under 37 C.F.R. §1.137(a), as having as abandoned due to unavoidable delay, or 37 C.F.R. §1.137(b), as having as abandoned due to unintentional delay.

For the reasons set forth below the petition as considered under 37 C.F.R. §1.181 is **DISMISSED**; the petition under 37 C.F.R. §1.137(a) is **DISMISSED**; and the petition under 37 C.F.R. §1.137(b) is **GRANTED**.

NOTE:

Petitioner appears to have a practice of not listing his registration number and contact information (telephone and mailing) on his papers, which practice makes it difficult to respond to the array of problems described in the instant petition.

Moreover, Petitioner presents a narrative of difficulties in accessing the instant application and/or data thereon, however, Petitioner apparently ignored the stated instructions—clearly set forth in the very documents Petitioner seeks to submit to demonstrate his difficulties—as to contacting the Office to resolve technical problems.

Statutes, the Rules of Practice and guidance for technical assistance provide many avenues for action and methods of protection for applicants, patentees, assignees, practitioners and others to accomplish tasks before the Office. However, persons who fail to utilize those statutes, rules and guidance fail to succeed in their tasks or obtain those protections.

BACKGROUND

The record reflects that:

- Petitioner failed to reply timely and properly to the *ex parte Quayle* action mailed on 24 February, 2005, with reply due absent an extension of time on or before Monday, 25 April, 2005—with a maximum deadline extension to 24 August, 2005;
- the instant application went abandoned after midnight 24 April, 2005;
- Petitioner's amendment, filed on 25 April, 2005, was found to be non-compliant, and the Notice of Non-Compliant Amendment was mailed on that date with a reply due absent extension of time on or before 25 May, 2005—and the language of the Notice expressly reminded Petitioner that the date of the Notice did not alter the statutory period for reply;
- Petitioner avers difficulties as early as March 2005 accessing information online, but states that he waited until 17 August, 2005, to establish a Private PAIR account;
- on 17 August, 2005, Petitioner filed a Notice of Change of Address—which in fact presented the same data long on file in the Office for Petitioner—but Petitioner still not file at that time a proper and timely reply to 24 February, 2005, action;
- Petitioner acknowledges that he waited further until 23 August, 2005—one day before the statutory deadline for reply—to attempt to contact the Examiner, whom, Petitioner complains, he could not reach immediately;
- on 25 August, 2005, Petitioner filed a reply to the 24 February, 2005, action and thus the first reply to the 25 April, 2005, Notice of Non-Compliant Amendment—all of which had a statutory reply deadline of 24 August, 2005;
- Petitioner supplemented his already-untimely 25 August, 2005, filing on 9 September, 2005;
- it does not appear that the Office mailed the Notice of Abandonment before the instant petition was filed;

- on 30 March, 2006, Petitioner filed the instant petition, averred his difficulties, included copies of his replies, authorized fees—though apparently failed to consult the Office website for current fee structures—requested relief alternatively as withdrawal of the holding of abandonment or revival of the application (referring, improvidently, to the petition as one regarding an “Inadvertently Abandoned” application and suggesting unavoidable delay while also authorizing the (approximate) fees for a petition alleging unintentional delay), but also fails to make either the showing of unavoidable delay or the express statement of unintentional delay as set forth as a requirement of the regulations at in the regulations at 37 C.F.R. §1.137(b);
- **although Petitioner fails to make the regulatory statement as to unintentional delay, in light of the representations presented the petition is read to so state, however, Petitioner John Halamka (Reg. No. 30,177) must notify the Office if this reading is in error, consistent with his duty of candor to the Office;**¹
- out of an abundance of caution, Petitioners always are reminded that the filing of a petition under 37 C.F.R. §1.181 does not toll any periods that may be running any action by the Office and a petition seeking relief under the regulation must be filed within two (2) months of the act complained of (see: 37 C.F.R. §1.181(f)), and those registered to practice *and* all others who make representations before the Office are reminded to inquire into the underlying facts of representations made to the Office and support averments with the appropriate documentation—since all owe to the Office the continuing duty to disclose.²

¹ See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing the statement required by 37 C.F.R. §1.137 to the Patent and Trademark Office).

² See supplement of 17 June, 1999. The Patent and Trademark Office is relying on petitioner’s duty of candor and good faith and accepting a statement made by Petitioner. See Changes to Patent Practice and Procedure, 62 Fed. Reg. at 53160 and 53178, 1203 Off. Gaz. Pat. Office at 88 and 103 (responses to comments 64 and 109)(applicant obligated under 37 C.F.R. §10.18 to inquire into the underlying facts and circumstances when providing statements to the Patent and Trademark Office).

Specifically, the regulations at 37 C.F.R. §10.18 provide:

§ 10.18 Signature and certificate for correspondence filed in the Patent and Trademark Office.

(a) For all documents filed in the Office in patent, trademark, and other non-patent matters, except for correspondence that is required to be signed by the applicant or party, each piece of correspondence filed by a practitioner in the Patent and Trademark Office must bear a signature by such practitioner complying with the provisions of §1.4(d), §1.4(e), or § 2.193(c)(1) of this chapter.

(b) By presenting to the Office (whether by signing, filing, submitting, or later advocating) any paper, the party presenting such paper, whether a practitioner or non-practitioner, is certifying that—

(1) All statements made therein of the party’s own knowledge are true, all statements made therein on information and belief are believed to be true, and all statements made therein are made with the knowledge that whoever, in any matter within the jurisdiction of the Patent and Trademark Office, knowingly and willfully falsifies, conceals, or covers up by any trick, scheme, or device a material fact, or makes any false, fictitious or fraudulent statements or representations, or makes or uses any false writing or document knowing the same to contain any false, fictitious or fraudulent statement or entry, shall be subject to the penalties set forth under 18 U.S.C. 1001, and that violations of this paragraph may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom; and

Rather than review the guidance set for in the Manual of Patent Examining Procedure (see: MPEP §711.03(c)—set forth in detail below for Petitioner’s reference) as to a showing in support of a request to withdraw the holding of abandonment, it appears that Petitioner instead goes on at length about his frustrations with the prosecution of the instant application before the Office. As a result, it appears that Petitioner fails even to state simply (and so satisfy part of his showing requirement) that he has examined his docket records and the file and file wrapper for the instant application and finds no evidence therein of receipt of the action(s) in question.

It appears that with the petition and fee, the reply in the form of an amendment, and Petitioner’s statements that the Office has indicated it will read as the statement of unintentional delay, Petitioner has satisfied the requirements under 37 C.F.R. §1.137(b).

STATUTES, REGULATIONS AND ANALYSIS

Congress has authorized the Commissioner to "revive an application if the delay is shown to the satisfaction of the Commissioner to have been "unavoidable." 35 U.S.C. §133 (1994).³

The regulations at 37 C.F.R. §1.137(a) and (b) set forth the requirements for a petitioner to revive a previously unavoidably or unintentionally, respectively, abandoned application under this

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- (2) To the best of the party’s knowledge, information and belief, formed after an inquiry reasonable under the circumstances, that —
- (i) The paper is not being presented for any improper purpose, such as to harass someone or to cause unnecessary delay or needless increase in the cost of prosecution before the Office;
 - (ii) The claims and other legal contentions therein are warranted by existing law or by a nonfrivolous argument for the extension, modification, or reversal of existing law or the establishment of new law;
 - (iii) The allegations and other factual contentions have evidentiary support or, if specifically so identified, are likely to have evidentiary support after a reasonable opportunity for further investigation or discovery; and
 - (iv) The denials of factual contentions are warranted on the evidence, or if specifically so identified, are reasonably based on a lack of information or belief.
- (c) Violations of paragraph (b)(1) of this section by a practitioner or non-practitioner may jeopardize the validity of the application or document, or the validity or enforceability of any patent, trademark registration, or certificate resulting therefrom. Violations of any of paragraphs (b)(2)(i) through (iv) of this section are, after notice and reasonable opportunity to respond, subject to such sanctions as deemed appropriate by the Commissioner, or the Commissioner’s designee, which may include, but are not limited to, any combination of —
- (1) Holding certain facts to have been established;
 - (2) Returning papers;
 - (3) Precluding a party from filing a paper, or presenting or contesting an issue;
 - (4) Imposing a monetary sanction;
 - (5) Requiring a terminal disclaimer for the period of the delay; or
 - (6) Terminating the proceedings in the Patent and Trademark Office.
- (d) Any practitioner violating the provisions of this section may also be subject to disciplinary action. See § 10.23(c)(15). [Added 50 FR 5175, Feb. 6, 1985, effective Mar. 8, 1985; para. (a) revised, 58 FR 54494, Oct. 22, 1993, effective Nov. 22, 1993; paras. (a) & (b) revised, paras. (c) & (d) added, 62 FR 53131, Oct. 10, 1997, effective Dec. 1, 1997; para. (a) revised, 69 FR 56481, Sept. 21, 2004, effective Oct. 21, 2004]

³ 35 U.S.C. §133 provides:

35 U.S.C. §133 Time for prosecuting application.

Upon failure of the applicant to prosecute the application within six months after any action therein, of which notice has been given or mailed to the applicant, or within such shorter time, not less than thirty days, as fixed by the Commissioner in such action, the application shall be regarded as abandoned by the parties thereto, unless it be shown to the satisfaction of the Commissioner that such delay was unavoidable.

congressional grant of authority. The language of 35 U.S.C. §133 and 37 C.F.R. §1.137(a) is clear, unambiguous, and without qualification: the delay in tendering the reply to the outstanding Office action, as well as filing the first petition seeking revival, must have been unavoidable for the reply now to be accepted on petition.⁴

Delays in responding properly raise the question whether delays are unavoidable.⁵ Where there is a question whether the delay was unavoidable, Petitioners must meet the burden of establishing that the delay was unavoidable within the meaning of 35 U.S.C. §133 and 37 C.F.R. §1.137(a).⁶ And the Petitioner must be diligent in attending to the matter.⁷ Failure to do so does not constitute the care required under Pratt, and so cannot satisfy the test for diligence and due care.

(By contrast, unintentional delays are those that do not satisfy the very strict statutory and regulatory requirements of unavoidable delay, and also, by definition, are not intentional.⁸))

Withdrawal of the Holding of Abandonment

The courts have determined the construct for properly supporting a petition seeking withdrawal of a holding of abandonment.⁹

Further, the commentary at MPEP §711.03(c) provides:

* * *

A. Petition To Withdraw Holding of Abandonment Based on Failure To Receive Office Action

In *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971), the court decided that the Office should mail a new Notice of Allowance in view of the evidence presented

⁴ Therefore, by example, an unavoidable delay in the payment of the Filing Fee might occur if a reply is shipped by the US Postal Service, but due to catastrophic accident, the delivery is not made.

⁵ See: *Changes to Patent Practice and Procedure; Final Rule Notice*, 62 Fed. Reg. at 53158-59 (October 10, 1997), 1203 Off. Gaz. Pat. Office at 86-87 (October 21, 1997).

⁶ See: In re Application of G, 11 USPQ2d 1378, 1380 (Comm'r Pats. 1989).

⁷ See: Diligence in Filing Petitions to Revive and Petitions to Withdraw the Holding of Abandonment, 1124 Off. Gaz. Pat. Office 33 (March 19, 1991). It was and is Petitioner's burden to exercise diligence in seeking either to have the holding of abandonment withdrawn or the application revived. See 1124 Off. Gaz. Pat. Office supra.

⁸ Therefore, by example, an unintentional delay in the reply might occur if the reply and transmittal form are to be prepared for shipment by the US Postal Service, but other pressing matters distract one's attention and the mail is not timely deposited for shipment.

⁹ See: *Delgar v. Schulyer*, 172 USPQ 513 (D.D.C. 1971).

in support of the contention that the applicant's representative did not receive the original Notice of Allowance. Under the reasoning of *Delgar*, an allegation that an Office action was never received may be considered in a petition to withdraw the holding of abandonment. If adequately supported, the Office may grant the petition to withdraw the holding of abandonment and remail the Office action. That is, the reasoning of *Delgar* is applicable regardless of whether an application is held abandoned for failure to timely pay the issue fee (35 U.S.C. 151) or for failure to prosecute (35 U.S.C. 133). To minimize costs and burdens to practitioners and the Office, the Office has modified the showing required to establish nonreceipt of an Office action. The showing required to establish nonreceipt of an Office communication must include a statement from the practitioner stating that the Office communication was not received by the practitioner and attesting to the fact that a search of the file jacket and docket records indicates that the Office communication was not received. A copy of the docket record where the nonreceived Office communication would have been entered had it been received and docketed must be attached to and referenced in practitioner's statement. For example, if a three month period for reply was set in the nonreceived Office action, a copy of the docket report showing all replies docketed for a date three months from the mail date of the nonreceived Office action must be submitted as documentary proof of nonreceipt of the Office action.

* * *

The showing outlined above may not be sufficient if there are circumstances that point to a conclusion that the Office action may have been lost after receipt rather than a conclusion that the Office action was lost in the mail (e.g., if the practitioner has a history of not receiving Office actions).

Evidence of nonreceipt of an Office communication or action (e.g., Notice of Abandonment or an advisory action) other than that action to which reply was required to avoid abandonment would not warrant withdrawal of the holding of abandonment. Abandonment takes place by operation of law for failure to reply to an Office action or timely pay the issue fee, not by operation of the mailing of a Notice of Abandonment. See *Lorenz v. Finkl*, 333 F.2d 885, 889-90, 142 USPQ 26, 29-30 (CCPA 1964); *Krahn v. Commissioner*, 15 USPQ2d 1823, 1824 (E.D. Va 1990); *In re Application of Fischer*, 6 USPQ2d 1573, 1574 (Comm'r Pat. 1988). (Emphasis supplied.)

* * *

And the regulation requires that relief be sought within two (2) months of the act complained of.

As of this writing Petitioner appears not to have satisfied and not to be able to satisfy the

showing requirements described above.

Allegations as to
Unavoidable Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(a) are the petition and fee, a statement/showing of unavoidable delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

Petitioner appears not to have satisfied these requirements.

Allegations as to
Unintentional Delay

The requirements for a grantable petition under 37 C.F.R. §1.137(b) are the petition and fee, a statement/showing of unintentional delay, a proper reply, and—where appropriate—a terminal disclaimer and fee.

The requirements for relief under the provisions of 37 C.F.R. §1.137(b) are: petition, fee, reply, showing of unintentional delay, and—where appropriate—a terminal disclaimer and fee.

Petitioner appears to have satisfied these requirements.

CONCLUSION

Because Petitioner has not satisfied the burdens set forth in Delgar v. Schulyer, the petition as considered under 37 C.F.R. §1.181 is **dismissed**; the petition under 37 C.F.R. §1.137(a) is **dismissed**; and the petition under 37 C.F.R. §1.137(b) is **granted**.

The application is released to the Examiner in Technology Center 3700 for further processing in due course.

Telephone inquiries concerning this decision may be directed to the undersigned at (571) 272-3214.



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